

REMARKS

The Applicants respectfully request further examination and consideration in view of the and arguments set forth fully below. Claims 1-13 and 15-17 were previously pending in this application. Claims 1-11, 16 and 17 have been allowed. Within the Office Action, Claims 12, 13 and 15 were rejected. Accordingly, Claims 1-13 and 15-17 are pending in this application.

Rejections Under 35 U.S.C. § 103(a)

It is stated within the Office Action that Claims 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK 2,339,834 to Rabenecker (hereinafter "Rabenecker") in view of U.S. Patent No. 5,890,634 to Zuckerman et al. (hereinafter "Zuckerman") and U.S. Patent No. 3,383,963 to Vondrachek (hereinafter "Vondrachek"). Specifically, it is stated within the Office Action that it would have been obvious to modify the nubbed adapter in Rabenecker so that the adapter bar is flat, as in Zuckerman, and has an extending feature centered along a width dimension as in Vondrachek. The Applicants respectfully traverse this rejection.

The present invention at issue is directed to an adapter which is removably coupled to the clip. It is preferred that the adapter extends out from the inside surface of the clip past the notch to provide a smooth surface on the inside of the clip. The adapter is preferably made of a frictional material which secures the article. The adapter includes a feature located substantially in the center of the adapter surface and extends from the adapter surface toward the inner surface of the clip. The feature frictionally fits within an aperture in the inner surface of the clip, thereby securing the adapter to the clip.

Rabenecker teaches a measuring instrument with a holder 1, whereby the holder secures the measuring instrument to the belt of the user. Rabenecker teaches a plate 8 which couples to the measuring instrument, whereby the plate 8 includes two apertures or cut outs 13, 14 which extend through the plate 8. Rabenecker teaches that a knob strip made of foam rubber is buttoned into the cut outs 13, 14 of the plate 8. As recognized by the Office Action, the adapter bar in Rabenecker is nubbed, not flat. Also recognized by the Office Action, there is no teaching in Rabenecker of the adapter bar having an extending feature that is substantially centered along a width direction. Further, the adapter bar in Rabenecker is buttoned into two apertures [Rabenecker, Figure 1, elements 13 and 14], not one.

Zuckerman teaches a clamp-type garment hanger which includes at least two clamp assemblies 20 for securing a garment. Each clamp assembly 20 includes a pair of removeable clamping members, whereby at least one clamping member has an inner clamping surface defined at least in part by at least one gripping pad. A first side of the gripping pad is carried by the inner clamping surface of the one clamping member, and a second side of the gripping pad is presented for contact with a garment to be hung from the garment hanger. Unlike the adapter bar in Rabenecker, which is buttoned into cutouts of the plate, the gripping pad in Zuckerman has a snap-in/snap-out relationship. Furthermore, the adapters (pads) of Zuckerman and Rabenecker are used for different purposes. The adapter in Rabenecker is provided for facilitating the coupling of the holder to various pieces of clothing, and does not fasten or otherwise contact the object that is to be secured, i.e. the measuring instrument. Also, the holder in Rabenecker is worn by a person. In contrast to Rabenecker, the gripping pad in Zuckerman contacts the garment to be hung from the hanger and is not worn on the body of persons. Zuckerman also discloses the gripping pad having two extending features, not one, and neither the extending features of Zuckerman nor the buttoned ends of Rabenecker are substantially centered along a width dimension on a surface of the pad.

Vondrachek teaches a wrench which obtains a tight purchase on an object from any given angle. The wrench in Vondrachek has a pair of moveable jaws arms with a supplemental V-shaped jaw feature swivelly mounted within one of the jaw arms. In particular, the wrench has an aperture within which accepts a shank that protrudes out from the V-shaped jaw feature. The V-shaped jaw feature is coupled to the wrench by inserting the shank member 22 into the aperture in the wrench, whereby the shank 22, when inserted within the aperture, allows the V-shaped jaw feature to rotate about an axis through the shank 22. The moving tool having mounted jaws in Vondrachek cannot be worn on the body of persons for purposes of securing objects to articles of clothing. Indeed, the V-shaped jaws of Vondrachek would harm or ruin any sort of clothing which the jaws would apply force to. Besides, the two end portions of the knob strip in Rabenecker cannot be centered along a width directions in view of Vondrachek because the two end portions of Rabenecker are designed to protrude from the inner surface of the plate to secure a garment. In contrast, the shank portion of Vondrachek allows the jaws to freely pivot or rotate about an axis. One skilled in the art would not find Vondrachek relevant to Rabenecker or Zuckerman and would have no motivation to combine Vondrachek with Rabenecker or Zuckerman to teach a particular invention. Vondrachek is in now way analogous art to either Rabenecker or Zuckerman.

As recognized within the Office Action, Rabenecker does not teach that the adapter bar is flat or that an extending feature is substantially centered along a width direction. Further, unlike the present invention, the adapter bar in Rabenecker is buttoned into two apertures, not one. However, it is concluded within the Office Action that it would have been obvious to a person of ordinary skill in the art to modify the adapter of Rabenecker so that the adapter bar is flat in view of Zuckerman and further have the extending feature centered along a width direction in view of Vondrachek. The Applicant respectfully disagrees with this conclusion.

The Applicants respectfully submit that the age of the cited references indicates a lack of some teaching or suggestion supporting the combination. Rabenecker was filed on January 7, 1999. Zuckerman was filed on December 18, 1997. Vondrachek has a filing date of March 3, 1967. Even with the benefit of a filing date that is one year later than Zuckerman and more than twenty years later than Vondrachek, Rabenecker still does not include some teaching or suggestion that the art taught in each reference can and should be combined. The Applicants respectfully submit that if the combination of the cited references was obvious, as is stated in the Office Action, then it is probable that such a combination would have been taught or suggested prior to the filing of the present application. As such, there is no teaching or suggestion in either references to make the combination made in the Office Action.

The Applicants respectfully submit that the Examiner is relying upon hindsight, having knowledge of the Applicants' own structure. But for this knowledge, the combination of references would not have occurred to the Examiner, as it did not occur to those skilled in the art to make the asserted combination. "Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'" *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988), quoting *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1012 (Fed. Cir. 1983). The combination proposed by the Examiner is being made only in light of his knowledge of the Applicants' disclosure.

The Applicants respectfully suggest that in the Office Action, the rejections evidence 'picking and choosing' features of the cited references and combining them when there is no suggestion in those references to do so. "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *Application of Wesslau*, 353 F.2d 238, 241 (C.C.P.A. 1965); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*, 796 F.2d 443, 448 (Fed. Cir. 1986),

cert. denied, 484 U.S. 823 (1987). Furthermore, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). Thus, teachings of references can be combined only if there is some suggestion or incentive to do so.

The amended Independent Claim 12 is directed to an adapter for providing a flat surface to a clip, wherein the clip is coupled to an object and having a segment which secures the object to an article worn by a person, the object having a surface adapted to be worn adjacent to the person, the adapter coupled to the segment and positioned between the segment and the surface of the object, wherein the adapter has an adapter length and an extending feature for removably coupling the adapter to the segment, the extending feature substantially centered along a width dimension on an interface surface of the adapter and positioned within an aperture between a first edge and a second edge of the segment. As described above, Rabenecker, Zuckerman and Vondrachek do not teach or suggest a combination of references to arrive at the invention of the present invention. For at least these reasons, the amended Independent Claim 12 is allowable over the teachings of Rabenecker in view of Zuckerman and Vondrachek.

Claims 13 and 15 are dependent upon the amended Independent Claim 12. As discussed above, the amended Independent Claim 12 is allowable over the teachings of Rabenecker in view of Zuckerman and Vondrachek. Accordingly, Claims 13 and 15 are also allowable as being dependent upon an allowable base claim.

For the reasons given above, the Applicants respectfully submit that the Claims 12, 13 and 15 are in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,
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Dated: 6-7-04

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CERTIFICATE OF MAILING (37 CFR § 1.6(a))

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